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600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
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WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

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15

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 15

Application Number: 09/437,499

Filing Date: 11/10/1999

Appellant(s): MATSUURA et. al.

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Edward Wise

For Appellant

Art Unit: 2626

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/10/2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1-6, 9, 12-15 and 17-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,921,537	MATSUI et al	7-1999
5,236,185	TANEDA et al	8-1993
5,852,764	KIDA et al	12-1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 3, 4, 5, 9, 12, 13, 14, 15, 17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kida et al (Kida) (U. S. 5,852,764).

With respect to claims 1, 2, 3, 9, 12, 15, 17, and 20, Kida discloses an image forming apparatus (5) comprising a plurality of trays (53 and 59) for receiving discharged sheets bearing a formed image; means for selectively setting the form of output with respect to the plural trays (the abstract, lines 13-15), and forming an image on the sheets in the form of output set when the tray which the form of output has been set is selected as the discharge tray (column 19, lines 25-45 and column 5, line 36 to column 20, line 6).

With regard to claim 4, Kida discloses forming the images on the obverse and reverse side of a sheet (column 5, lines 54-63).

With respect to claim 5, Kida discloses forming plural images on the sheet (which reads on composite copying) (column 5, lines 41-59).

With regard to claims 13 and 14, Kida discloses setting the size of sheets to be discharged (column 28, lines 12-19).

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*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kida in view of Matsui et al (Matsui) (U. S. 5,921,537).

With respect to claim 6, Kida differs from claim 6 in that he does not clearly disclose the plural trays are allocated to a specific user. Matsui discloses a printing system whereby bins are allotted to various operators (column 12, lines 57-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kida wherein the plural trays are allocated to a specific user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kida by the teaching of Matsui in order to simplify the discharge process.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kida in view of Taneda (U. S. 5,236,185).

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With respect to claims 18 and 19, Kida differs from claims 18 and 19 in that he does not clearly disclose that the post handling includes stapling and punching. Taneda discloses an image forming method wherein post handling includes stapling and punching (column 6, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kida wherein post handling includes stapling and punching. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kida by the teaching of Taneda in order to improve the post processing capabilities.

***Allowable Subject Matter***

7. Claims 7, 8, 10, 11, 16, 21, 22, and 23 are allowed.

***(11) Response to Argument***

Applicant submits that *Kida* does not disclose actually forming an image(s) on the sheet in the form that has been set by a setting means. The Examiner respectfully disagrees.

*Kida* discloses that one of the discharge trays (53 or 59) can be selected as desired according to a selected image forming mode apparatus and a sheet can be discharged onto the discharge tray as selected according to the image forming mode (column 4, line 66 to column 5, line 3). *Kida* also discloses selecting the discharge end of a sheet (P) **having an image formed thereon** (emphasis added) according to an image forming mode such as a fax mode, a printer mode or a copy mode, wherein the user can set the discharge end as desired according to each image forming mode (column 18, lines 60-67). An image formed from a facsimile transmission would be of a different “form” than a copy or print image. For example, the facsimile

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image would have various features (header and sender/recipient addresses) that would not be on the copy or print images. Therefore, *Kida* clearly discloses forming an image(s) (the facsimile, copy or print images) on the sheet in the form that has been set by a setting means.

*Kida* also discloses a plurality of trays (53 and 59) for receiving discharged sheets (column 14, lines 5-12) bearing a **formed image** (column 4, lines 9-15), a setting means (figure 5) for selectively setting **the form** of output (double-sided or face-up or face-down) (column 19, lines 8-36 and column 30, lines 33-67) with respect to at least one of the plurality of trays (column 30, lines 47-59), and an image forming unit (5) for **forming an image on the sheets in the form of output** set by said setting means **when the tray which the form of output has been set is selected** as the destination of discharged sheet (when a discharge tray 53 or 59 is selected, double sided copying is performed) (column 30, lines 46-57). *Kida* further discloses that in the case where the apparatus is operated in the double-sided image mode, the discharge state "E" is selected, wherein discharge tray 53 is selected for discharge of the sheet (column 35, lines 30-36).

With respect to claim 12, Applicant submits that *Kida* does not disclose supplying sheets of a size set by a setting means by selecting the tray for which that size sheet has been set as the sheet discharge tray. Again, the Examiner disagrees.

*Kida* discloses setting the sheet size of the discharge trays (column 40, lines 12-52) and preventing sheets of a particular size to be discharged onto particular trays.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark Wallerson

MARK WALLERSON  
PRIMARY EXAMINER



December 6, 2001

Conferees

Kimberly Williams, SPE

Gabriel Garcia, Primary Examiner

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PRIMARY EXAMINER

